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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965.

No. 612

M. B. SKINNER COMPANY,

Petitioner,

vs.

CONTINENTAL INDUSTRIES, INC.,

Respondent.

PETITIONER'S BRIEF IN REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI.

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Respondent's brief not only fails to address itself to the questions presented in the Petition but erroneously characterizes those questions.

The first question presented by petitioner deals with the erroneous standard of patentability applied by the courts below. Based on a scrambling of statements taken from the decision below and the Petition, respondent mistakenly characterizes petitioner's argument as: "Thus, Petitioner urges that the 'unobviousness' test of Section 103 is wholly satisfied by a 'new . . . result'—*i.e., merely novelty.*" (Br. 4) (Emphasis in original.)

Petitioner has never made such an argument. It is clear from even a most strained interpretation of the petition

that unobiousness is not equated with novelty. The Petition states: "It is petitioner's position that failure to find a new result from the combination of old elements has no bearing on whether the improvement was obvious to those skilled in the art." (Pet. 7.) Nor does petitioner assert that the Constitutional provision (Act I, Sec. 8) is limited to requiring novelty only. The Petition also states: "The statute only requires that the combination be unobvious to one skilled in the art." (Pet. 5.)

Respondent's discussion of question 1 is therefore entirely meaningless because it fails to direct itself to the question presented.

Question 2 involves the lower court's improper characterization of claims 1, 2 and 3 of Patent 2,990,731 as combination claims. Respondent argues that even if these claims are directed to the punching element only, the courts below specifically held those claims anticipated by the Alsaker reference. Respondent fails to note that portion of the court of appeals' opinion cited previously at Pet. 12: "There is no single aspect of appellants T-fittings that is totally new, with the possible exception of the punching tip *which is different from the prior art relied upon by appellee and the Patent Office.*" (Emphasis added.) 346 F. 2d 173. Since the tip is different there obviously could be no anticipation.

The courts erred in not finding the claims directed to a tip per se but if, as respondent argues, the court of appeals did hold the claims directed to the tip per se it erred in finding the claims anticipated.

Conclusion.

Petitioner respectfully requests that a Writ of Certiorari issue for the reasons set forth in its Petition.

Respectfully submitted,

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